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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,219	12/03/2003	Brian John Roberts	12406/88	7993
<div>26646      7590      12/10/2007</div> <div>KENYON &amp; KENYON LLP</div> <div>ONE BROADWAY</div> <div>NEW YORK, NY 10004</div>				
			<div>EXAMINER</div> <div>LEIVA, FRANK M</div>	
			<div>ART UNIT</div> <div>3714</div>	<div>PAPER NUMBER</div>
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/728,219

Applicant(s)

ROBERTS, BRIAN JOHN

Examiner

Frank M. Leiva

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-39 and 43-59 is/are pending in the application.
- 4a) Of the above claim(s) 57-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-39, 43-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 57-59 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 57-59 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: new claim 57 incorporated a skill based game, where the originally claimed lottery is a purely chance based game, and new claims 58-59 are drawn to event based wagering, and specifically sports related wagering, where the originally claimed invention is drawn to a lottery system and specifically an instant and interactive lottery game system.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 57-59 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 27 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye (US 5,569,082), in view of Roberts (US 5,772,510).**

4. **Regarding claims 27 and 48; Kaye discloses:**

A lottery gaming system, comprising: a lottery ticket, the lottery ticket including a ticket identifier, an interactive game information, and an instant game information, and a removable covering concealing the instant game information, (col. 1:25-35).

A lottery ticket dispenser configured to dispense the lottery ticket, (col. 4:40-52).

The lottery ticket dispenser configured, responsive to receiving the input indicating the player's choice to purchase the lottery ticket, (col. 4:40-52), without activating the lottery ticket for use in the interactive game, to dispense the lottery ticket without activating the lottery ticket for use in the interactive game, (col. 7:45-54; where a player may choose on a menu to play either a simple "lotto" game or an interactive 'horses game' using a lottery ticket).

A central computer system in communication with the lottery ticket dispenser and configured to receive from the lottery ticket dispenser an indication that the player has chosen to purchase the lottery ticket for use in the interactive game, the central computer system configured to, responsive to the receipt of the indication, to activate the lottery ticket for use in the interactive game, (col. 4:40-52; where a central single computer network controls lottery information and distribution), and a computing device remote from and in communication with the central computer system, the computing device configured to receive the interactive game information from the lottery ticket, the computing device further configured to be utilized by the player to play the interactive game based at least in part on the interactive game information, (col. 3:4-12).

Kaye fails to disclose games without the features of his invention (destiny bonus), yet shows the ability of the player to choose among a selection of different games.

Roberts discloses: A lottery ticket dispenser configured to dispense the lottery ticket, the lottery ticket dispenser including an input device configured to receive, prior to the lottery ticket being dispensed, an input indicating a player's choice between purchasing the lottery ticket as a hybrid instant lottery ticket that is also usable in an interactive game and purchasing the lottery ticket without activating the lottery ticket for use in the interactive game, (fig. 7 and description; whereas the dispenser contains games that are scratch off and games that are not).

5. **Regarding claims 27 and 48;** It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the vending machine style of Roberts to

the Kaye invention to reach more types of gamblers and combined them into a single system. This would not be novel but the application of well known dispensing apparatuses.

6. **Regarding Claims 28 and 50**, Kaye discloses a lottery gaming system wherein the lottery ticket dispenser includes a printer configured to print the interactive game information on the lottery ticket responsive to the indication that the player has chosen to purchase the lottery ticket for use in the interactive game (col. 3:4–12).

7. **Regarding Claims 29 and 49**, Kaye discloses a lottery game system wherein the lottery ticket is pre-printed with the interactive game information, the ticket dispenser including a reader configured to read the ticket identifier from the lottery ticket prior to the ticket being activated for use in the interactive game (col. 4:53–61; where tickets are preprinted using a ticket dispenser and are read by an amusement and actualization player terminal).

8. **Regarding Claim 30**, Kaye discloses a lottery game system, wherein the reader is configured to read the ticket identifier from the lottery ticket prior to the lottery ticket being dispensed (col. 3:4–18; where destiny codes can be re-read after printing in order to increase security as is well known in the art of lottery ticket generation).

9. **Regarding Claims 31 and 51**, Kaye discloses a lottery game system, wherein the ticket dispenser is further configured to communicate the ticket identifier read from the lottery ticket to the central computer (col. 4:46–52; where a ticket dispenser may be a terminal that reads destiny codes for interactive games from a central computer system which controls all codes, including verification of printed codes as is well known in the art of lottery ticket generation).

10. **Regarding Claims 32 and 53**, Kaye discloses a lottery game system wherein the ticket identifier and interactive game information are encoded in a bar code (col. 2:55–58;

col. 3:7–12; where a bar code is a type of symbolic encryption that may be used to encrypt destiny codes that may be stored on a paper medium).

11. **Regarding Claim 33**, Kaye discloses a lottery game system wherein the ticket identifier and interactive game information are separate and apart on the ticket (col. 7:20–24; where interactive game information is stored in a destiny code and a ticket identification serial number history is stored in a separate location).

12. **Regarding Claim 34**, Kaye discloses a lottery gaming system wherein the interactive game information includes an access code configured to permit the player to access the interactive game (col. 3:23–25).

13. **Regarding Claims 35 – 36**, Kaye discloses a lottery gaming system wherein the computing device is in communication with the central computer system via the Internet and the interactive game information includes an Internet address where the player can access the interactive game (col. 9:1–3; where an on-line component for games is used, which may include the Internet).

14. **Regarding Claim 37**, Kaye discloses a lottery gaming system wherein the computing device is remote from the lottery ticket dispenser (col. 3:4–15; col. 4:53–61).

15. **Regarding Claims 43 – 44**, Kaye discloses a lottery gaming system wherein the interactive game information is pre-printed on the lottery ticket and activated in response to a transmission of the identifier to the central computer system (col. 3:23–25) and the central computer system is further configured to transmit the interactive game information to the ticket dispenser and wherein the ticket dispenser is configured, responsive to the receipt of the interactive game information from the central computer, to print the interactive game information on the game ticket (col. 6:1–6).

16. **Regarding Claims 45 – 46**, Kaye discloses a lottery gaming system wherein the removable covering is a scratch-off layer and wherein the removable covering includes the interactive game information (col. 1:25–32; where a removable covering includes game information).

17. **Regarding Claim 52**, Kaye discloses a method wherein the activating the lottery ticket occurs prior to providing the player the lottery ticket (col. 3:16– 5; where a destiny code is generated and activated by a dispenser before it is given to a player, and later verified for use in an interactive game).

18. **Regarding Claim 54**, Kaye discloses a method including crediting an account of the player if the player wins the interactive game (col. 8:48–61).

19. **Regarding Claim 38**, Kaye discloses a lottery gaming system wherein the computing device is remote from the lottery ticket dispenser (col. 3:4–15; col. 4:53–61), but does not disclose that the computing device is incorporated into the lottery ticket dispenser. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the game system using separate lottery dispensing and player terminals of Kaye with an integrated lottery dispensing and player terminal in order to increase convenience for a player by providing all elements of a gaming system in one location.

20. **Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye, as applied to claims above in view of Roberts (U.S. Patent 5,772,510).**

21. **Regarding Claim 47**, Kaye discloses a lottery ticket, but does not disclose a specific method of storing lottery tickets. However, Roberts teaches a lottery ticket wherein the lottery ticket is releasably coupled by lines of weakness to additional lottery tickets in a fan fold stack of lottery tickets (col. 3:29–30), in order to organize tickets for dispensing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the lottery and interactive game system using tickets of Kaye with the fan folded tickets of Roberts in order to better organize tickets for dispensing.

**22. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye, as applied to claims above in view of Fitzpatrick et al. (U.S. Patent 5,356,144).**

**23. Regarding Claim 39,** Kaye discloses a lottery gaming system, with a computing device, but does not disclose a portable device. However, Fitzpatrick teaches a computing device wherein the computing device is a handheld device (col. 2:23–55), in order to increase convenience for a player. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the non-portable lottery generating device of Kaye with the portable lottery device of Fitzpatrick in order to increase convenience for a player.

**24. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye as applied to claim 48 above, and further in view of Mullins (US 5,158,293).**

**25. Regarding Claim 55 and 56;** Kaye discloses all the limitations recited in claim 48 from which claims 55 and 56 depend on, although Kaye is silent about continuing the game after an instant win. Mullins discloses providing the interactive game information on the removable covering; after the removable covering has been removed by the player, receiving a tender of the lottery ticket without the removable covering for a prize in the instant win game; responsive to receiving the tender of the lottery ticket, redeeming the lottery ticket for a the prize in the instant win game; and providing the interactive game play to the player at the computing device after the player has redeemed the lottery ticket for a prize in the instant win game; the receiving at least a portion of the interactive game information from the ticket at the computing device occurs after the tender of the lottery



ticket, the interactive game information being provided by the player from removable covering, (abstract, col. 2:25-63; in which Mullins covers a lottery ticket with a redeemable instant win and keeping the remainder of the ticket for accumulation of letters for the progressive win).

26. **Regarding claims 55 and 56;** It would have been obvious to one of ordinary skill in the art at the time of the invention to use the very well known method of Mullins in the Kaye invention to introduce yet another winning level in the game. These features are not novel but very well known methods of entertainment in the lottery arts, which yield a predictable result.

#### ***Response to Arguments***

27. Applicant's arguments with respect to claims 27-59 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 9:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

12/03/2007

Robert E Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714

  
XUAN M. THAI  
SUPERVISORY PATENT EXAMINER